

(d) Remarks

The Claims are 1-11 and 14-18, with Claims 1, 17 and 18 being independent. The subject matter of Claims 12 and 13 has been added to the independent claims. In addition, the subject matter on page 7, lines 10-24 has been added to the independent claims. Claims 1, 14, 17 and 18 have accordingly been amended to define still more clearly what Applicants regard as their invention. Reconsideration of the claims is respectfully requested.

The Specification has been amended only to correct minor syntax errors. No new matter has been added.

The Examiner has rejected Claims 1, 6, 8-10, 17 and 18 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to define “high-molecular-weight”. Without necessarily agreeing and solely to expedite prosecution, the claims have been amended pursuant to the Examiner’s suggestion on page 3 of the Office Action to clarify “high-molecular-weight”.

Claims 1-18 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,630,566 B1 (Allen et al.) in view of U.S. Patent Nos. 5,804,343 (Umeda et al.) and 4,680,373 (Gallagher et al.) The reasons for these rejections are respectfully traversed.

Allen et al. relates to a polymeric material and composition for charge transport material. This reference is said to discuss a charge transport polymer that is an amine according to Formula 1. However, as conceded by the Examiner at page 2 of the Office Action, “Allen fails to teach the random copolymer or the various amine polymeric material.”

Gallagher relates to a multi-step process for the production of random copolymers. At best, a combination of Gallagher and Allen would result in an electrophotographic photosensitive member wherein the random copolymer is obtained by a multi-step process. In contrast, as illustrated in the Synthesis Examples at pages 43-46 of the specification, two or more kinds of monomers are simultaneously reacted in a single step during synthesis of the copolymers in Applicants' invention. Indeed, Gallagher describes the invention at Column 7, lines 17-18 as allegedly "overcom[ing] the disadvantages of reacting in one step."

The defects of Allen and Gallagher are not remedied by Umeda. Applicants understand Umeda as directed to an electrophotographic photoconductor, with various polymeric charge transporting materials listed as capable of being employed in the charge generation layer. Particularly significant, however, is the statement at Column 5, line 66 - Column 6, line 3, where Umeda indicates that the average molecular weight of the charge transport material selected is "more preferably in the range of 10,000 to 1,000,000." Conversely, the desired molecular weight of materials in Applicants' claimed invention is between 1,500 and 9,000, as evidenced by the results of the Examples listed in Tables 3-4. See specification, page 12, lines 21-26 and pages 51 and 52. Accordingly, by reciting a charge transport material with a molecular weight larger by four to six orders of magnitude as a preferred embodiment, Umeda actually teaches away from the present invention.

It is therefore respectfully submitted that Claim 1 is patentable over the combination of Allen with Gallagher and Umeda, and withdrawal of the rejection under 35 U.S.C. § 103(a) is earnestly requested. Independent Claims 17 and 18, directed to a

process cartridge and electrophotographic apparatus, respectively, also recite the features discussed above, and are therefore believed patentable for at least the same reasons.

Claims 1-18 were provisionally rejected as an obviousness-type double patenting over Claims 1-19 of copending application 10/422,733, and over Claims 1-11 of copending application 10/647,274. These rejections are respectfully traversed.

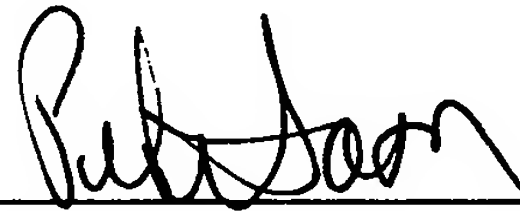
The Examiner will understand that there exist specific, significant claimed differences between the present claims and those of the above copending applications. In particular, principal independent Claim 6 of Application No. 10/422,733 includes a charge-transporting material having “an energy level of highest occupied molecular orbital,  $E_{\text{HOMO}}$ , of from -8.3 eV or more to -8.0 V or less as found by semiempirical molecular-orbital calculation.” Further, Claim 1 of 10/647,274 recites that “the ratio of the weight-average molecular weight Mw of the high-molecular-weight charge-transporting material to a number-average molecular weight Mn of the high-molecular-weight-charge-transporting material, Mw/Mn, is from more than 1.00 to 1.10 or less”. Neither of these distinct features is claimed in the present invention, and thus, each constitutes more than a colorable difference among the respective applications. Further, the present claims include a specifically synthesized random copolymer which feature is not claimed in the cited copending applications. Accordingly, the present claims define more than an obvious variation of the copending claims, reciting an entirely separate feature so as to be patentably distinct.

In addition, the copending applications have not yet issued. If the provisional double patenting rejection is the sole remaining rejection, MPEP § 804(I)(B) provides that the Examiner should allow the present application to issue.

In view of the foregoing amendments and remarks, Applicants respectfully request favorable reconsideration and the allowance of the present application.

Applicants' undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Saxon", written over a horizontal line.

Peter Saxon  
Attorney for Applicants  
Registration No.: 24,947

FITZPATRICK, CELLA, HARPER & SCINTO  
30 Rockefeller Plaza  
New York, New York 10112-3801  
Facsimile: (212) 218-2200